

Serial No. 10/043,426

Response to Office Action

Examiner: Reilly, Sean M.
Group Art Unit: 2153REMARKS

In reply to applicants' response of 7/14/2005, the Office prepared a new office action mailed 10/7/2005, in which it is alleged that applicants' response was not fully responsive as required by 37 CFR 1.111, because "applicant failed to point out any limitation or limitations which are believed to be unobvious over the claims of Applications 10/044632 and 10/044144" nor "present any rationale as to why such limitations are unobvious over the claims" of those applications.

The Office proceeds under a misunderstanding of 37 CFR 1.111. The requirement forwarded by the Office relates to the requirement of 37 CFR 1.111(c), which reads:

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

The interpretation of the Office is erroneous, first because the claims of applications 10/044632 and 10/044144 are not representative of the state of the art either at the time this application was filed or at the time the inventions were made. Because the requirement of 37 CFR 1.111 referred to by the Office refers to the "state of the art", this requirement can only apply to rejections under 35 U.S.C. §§ 102 or 103, and is not applicable to rejections for double patenting. Indeed, in the applicants' view, if they were to provide the response requested by the office, that could be construed as an admission that the claims of applications 10/044632 and 10/044144 are prior art. Applicants decline to make that admission.

Second, with regard to the "rationale" requirement put forth by the Office (presumably referring to the last sentence of 37 CFR 1.111(c)), applicants are not required to demonstrate why

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particular limitations are unobvious, but rather applicants must "also show how the amendments avoid such references or objections".

In applicants prior response of 7/14/2005 the following statements were made:

"All of new claims 30-51 include a limitation referencing a notification channel or a notification channel protocol." (p. 15, followed by discussion of specific claims language.)

"Applicants have canceled claims 1-29, rendering this provisional rejection moot. Applicants have provided new claims 30-51 which include elements believed to be unobvious over the claims of Application No. 10/044,632." (p. 16)

"Applicants have canceled claims 1-29, rendering this provisional rejection moot. Applicants have provided new claims 30-51 which include elements believed to be unobvious over the claims of Application No. 10/044,114." (p. 16)

Applicants did not set forth all claim elements that are unobvious over the claims of the other applications, and applicants are not required by 37 CFR 1.111 to do so. Applicants did, however, state that all of new claims 30-51 reference either a notification channel or a notification channel protocol. A comparison of these claims against the pending claims (as amended) of the other applications will reveal the absence of those claim elements, making the claims of this application at least an unobvious variation (see MPEP §804 II(B)1 on p. 800-21.) To the extent that 37 CFR 1.111 was not met by applicants' prior response, the showing under 37 CFR 1.111 "how the amendments avoid such references or objections" is now complete.

In the office action of 3/18/2005 the Office did not put forward sufficient grounds to support the obviousness-type double patenting rejections. Such a rejection parallels a rejection under 35 U.S.C. 103, with the exception that a patent or patent application is used rather than a reference in the prior art (MPEP §804(II)(B)(1), 2nd paragraph and §804 (III)). The Office provided only the blanket grounds that "although the conflicting claims are not identical, they are not patentably distinct from each other." The Office did compare originally filed claim 26 with certain of the

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claims of the other applications, with allegations that the claims are directed to "substantially identical" inventions or "substantially incorporates" the limitations of other claims. Such a comparison might be sufficient to support a statutory-type double patenting rejection for the claims that were compared, where the same invention was claimed in two independent applications. Applicants cannot say what "substantially similar" means in the obviousness-type double patenting context, as it is not clear where that standard originates from or how it would apply. Even if the claims incorporate "substantially similar" or even identical limitations, that is not sufficient grounds to support an obviousness-type double patenting rejection where one of the claims includes other limitations that have not been shown to be obvious over the limitations of a claim in a different patent or patent application.

To support its rejection, the Office must provide a prima facie case of obviousness for each claim alleged to be obvious over the claims of another application, which requires the showing of one-way obviousness discussed in MPEP §804 II(B)1(a):

If the application at issue is the later filed application or both are filed on the same day, only a one-way determination of obviousness is needed in resolving the issue of double patenting, i.e., whether the invention defined in a claim in the application *>would have been< an obvious variation of the invention defined in a claim in the patent. See, e.g., *In re Berg*, >140 F.3d 1438,< 46 USPQ2d 1226 (Fed. Cir. 1998) (the court applied a one-way test where both applications were filed the same day). If a claimed invention in the application *>would have been< obvious over a claimed invention in the patent, there would be an unjustified timewise extension of the patent and an obvious-type double patenting rejection is proper. Unless a claimed invention in the application *>would have been< obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type should be made, but this does not necessarily preclude a rejection based on another type of nonstatutory double patenting (see MPEP § 804, paragraph II.B.2. below).

Applicants believe that MPEP §804 II(B)2 does not apply under these circumstances, because granting two or all three of applicants' applications would not result in a substantial patent term extension.

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Therefore, for each claim rejection which obviousness-type double patenting is asserted, the Office must show the elements of a prima facie case of obviousness described in MPEP § 2142, page 2100-134 of (1) a motivation to combine the claims elements and (2) a reasonable expectation of success (the third requirement of teaching or suggestion of all the claims limitations is moot, as the claims limitations are considered to be disclosed in the claims themselves.) Applicants remind that it is not enough to show that the additional claims limitations can be combined (MPEP § 2143.01(III-IV), p. 2100-137) or that the combination is taught by the instant applications filed on the same date (showing only that the combination was known to the inventors but not within the knowledge of persons of ordinary skill in the art.)

Because the cited grounds were not sufficiently particular to support a rejection of obviousness-type double patenting, applicants could not say whether the inclusion of particular limitations of the claims as amended avoided the rejections, and therefore did not make a particular statement under 37 CFR 1.111(c). Should the Office provide more detailed and sufficient grounds of rejection, applicants can reply with the particularity that seems to have been expected.

37 CFR 1.104 and 1.111 set forth a procedure of examination for all applications. The Office is to provide grounds of rejection, and the applicant is to rebut by specifically pointing out the supposed errors in the examiner's action. The burden of forming and disclosing grounds of rejection is therefore on the Office, and not the applicant(s). (It would be absurd to require an applicant to write a rejection for his own application.) When the Office does not support its rejections with sufficient grounds, the applicant(s) are left to guess what the position of the Office is. Applicants therefore appreciate the efforts of the Office in providing detailed and complete grounds for each rejection made.

Finally, applicants are not averse to the filing of a terminal disclaimer, if it is necessary. At this time, none of the trio of applicants' applications have been allowed or issued, and the filing of a

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terminal disclaimer at this time would only serve to unnecessarily shorten the terms of patents for which term extensions would apply. Applicants therefore request that this provisional rejection be withdrawn without prejudice, and should claims be identified that would be allowable but for the issue of obviousness-type double patenting, the Office can re-assert the rejection providing grounds as appropriate.

The applicant's representative is available at the telephone number below, should there be any questions.

Respectfully submitted this 7 day of November, 2005.



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